



DOCKET NO. US2005-834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Appeal No.: Unknown
In re application of: Michael Anthony Eastman
Serial No.: 10/719,834
Filed: 24 November 2003
10 Title: Compact Mirrored Contact Lens Case
Art Unit: 3728
Examiner: Shian T. Luong

APPEAL BRIEF TRANSMITTAL FORM

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Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

Sir/Madam:

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Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellant(s) in connection with the above-identified application.

The enclosed document is being transmitted via the Certificate of Mailing Provisions of 37 CFR
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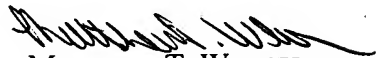
A notice of appeal was filed on January 1, 2007, with this Appeal Brief.

Appellant claims small entity status. See 37 CFR 1.27. Therefore, the fee for filing a brief in
30 support of an appeal of \$500 is reduced by half and the resulting fee is \$250.

A check for the payment of the \$250 Appeal Brief fee is enclosed.

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Respectfully submitted,


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APPELLANT'S BRIEF

15 Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

Sir/Madam:

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Enclosed in an appeal from the final rejection dated September 1, 2006, finally rejecting
claims 1-14. No claims have been cancelled.

I. Real Party in Interest

The real party in interest is the party identified on the brief as the sole inventor, Michael
25 Anthony Eastman.

II. Related Appeal or Interferences

There are no appeals or interferences known to appellant, or the appellant's legal
representative (there is no assignee) which will directly affect or be directly affected by or have a
bearing on the Board's decision in this pending appeal.

III. Status of Claims on Appeal

Claims 1-14 remain in the application and stand rejected. No claims have been allowed.

VI. Status of the Amendments

No amendments have been presented after the Final Office Action issued on September 1, 2006.

V. Summary of the Invention

The present invention comprises a novel contact lens case that provides a compactly configured storage container for storing contact lenses and a reflective surface for conveniently viewing the insertion and abstraction of the contact lens into or from the eye. The contact lens case is design so that it can be inexpensively molded out of a polymer. The contact lens case includes two reservoirs that share a common circular bottom wall. The reservoirs are coaxially oriented and are threaded to accept cylindrical closer caps that seal the reservoirs from loss of fluid and the entry of contaminants. The cylindrical closure caps engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. Furthermore, the top-end surface of one or more of the cylindrical closure caps has adhered to or embedded into said cylindrical closure cap a reflective surface, a mirror for example, allowing, as its primary function, the user to view the insertion or abstraction of the contact lens into or from the eye.

The user will hold the cylindrical closure cap containing the reflective surface (e.g. mirror) directly in front of the eye with one hand while inserting or abstracting the contact lens into or from the same eye with the opposite hand. Thus allowing the user to view, at close proximity, the action heretofore described.

VI. References Relied Upon in the Final Rejection

In the September 1, 2006 Final Office Action and Rejection, the Examiner relied on the following references:

- U.S. Patent 3,211,281 issued to Speshyock, et al. published on October 12, 1965
- U.S. Patent 2,650,597 issued to Girard and published on September 1, 1953
- U.S. Patent 1,655,452 issued to Ament and published on January 10, 1928
- U.S. Patent 3,822,780 issued to Ulmer and published on July 9, 1974
- U.S. Patent Des. 358,477 issued to De Meo and published on May 23, 1995
- U.S. Patent 5,433,314 issued to Lin and published on July 18, 1995

VII. Issues on Appeal

The issues on appeal are whether:

- a) Claims 9, 12, and 14 on the basis of Under 35 USC 112, first and second paragraphs fail to comply with the written description requirement and are indefinite;
- b) The subject matter of Claims 1, 4, and 6 are unpatentable in view of Speshyock, et al. and Girard, or Ament under 35 USC 102; and
- c) The subject matter of Claims 1-14 are unpatentable in view of Ulmer, et al., Girard, Ament, De Meo, and Lin.

With respect to Claims 2-3 and 7-8 Appellant concedes that it is known in the prior art to engage the cap to the base of a contact lens by thread as disclosed by Lin '314. Appellant respectfully relies on the arguments present below for Claim 1, from which Claims 2 and 3 depend, and Claim 6 from which Claims 7 and 8 depend.

VIII. Grouping of Claims

All claims are directed to a compactly configured contact lens case for storing contact lenses which includes at least one mirrored closure cap wherein the mirror is viewable as the top surface of the closure cap. The contact lens case includes two reservoirs that share a common base and are coaxially oriented and threaded to accept cylindrical closure caps that engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. The mirrors' primary function is to provide a close proximity view of the insertion or abstraction of the contact lens into or from the users' eye. The user will hold the mirrored closure cap directly in front of the eye with one hand, while performing the act of inserting or abstracting the contact lens into or from the eye with the opposite hand.

Claim 1 is an independent claims to which Claim 2, 3, 4, 5, and 13 depend. Claim 6 is an independent claim to which claims 7, 8, 9, 12, and 14 depend. Claim 10 is an independent claim to which Claim 11 depends.

IX. Statement of the Grounds of Rejection

Issue (a). Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. With respect to 35 USC 112, first paragraph, Examiner alleges the phrase “compression forces” has no support in the original specification and that adhering or embedding is not an equivalent means of securing. With respect to 35 USC 112, second paragraph, Examiner alleges that it is not clear what “embedding means or compression forces is exerted toward the center of the depth of the basin” means in context of the invention.

Issue (b). Examiner alleges that the subject matter of Claims 1 and 4 are unpatentable in view of Speshyock, et al. and Girard, or Amet under 35 USC 102. The Examiner’s position is that

the claim language does not differentiate the present invention from those in the prior art and that Speshyock's cover and base have met all the claim limitations of claim 1. There is no analysis or reasoning for the rejection of the claim elements found in Claims 2-4.

Issue (c). Claims 1-14 are unpatentable in view of Ulmer, et al., Girard, Ament, De Meo, and Lin. Examiner alleges, for claim 6 and 1-14 in general, that under *In re Oetiker*, that there is no reason to provide a citation or example that teaches a claim element, and that a statement that such is obvious is sufficient to find obviousness.

With respect to claims 1-14 in general Examiner again alleges that it would be obvious to secure in the claimed manner, and that it is within the discretion of the Examiner to "interchange the terms 'container' and 'caps' as long as the structure fits the terms."

With respect to claims 1, 4, and 5, Examiner alleges that the claimed invention is unpatentable over De Meo in view of Girard and/or Ament stating "De Meo *appears* to have a reflective surface" and that Ament teaches "a mirror spun or crimped or suitably secured to the cap", both without references in the citations to where these claim elements are taught or suggested.

X. Arguments

Issue (a). Claims 9, 12, and 14 comply with 35 USC 112, first and second paragraphs as they specification supports the claim elements and the claim elements are clearly defined either by their plain language definition or as defined in the specification.

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Examiner claims the phrase "compression forces" has no support in the original specification. Appellant concedes that the application does not explicitly state that the mirror is retained within the depth of the basin with a "compression force".

Appellant's position is that the "embedding" and "adhesion" methods and means taught by the specification are well known in the manufacturing prior arts and that "embedding" involves a process comprising the steps of placing a slightly oversized object into a recess on the surface of another object, wherein by forcing the slightly oversized object into the recess,
5 compression forces are created by the depth of the recess in order to retain the slightly oversized object in place. This process of embedding, which inherently includes "compression forces", is well known process in the manufacturing arts.

Embed is defined as: 1. to fix into a surrounding mass: to embed stones in cement; or 2. to surround tightly or firmly; envelop or enclose: Thick cotton padding embedded the precious
10 vase in its box. In the claims the use of "securing means", "embedding means", and "compression forces" are defined in the specification as embedding. Embedding is one manner of securing the mirror to the cap, and the use of "compression forces" which are created by placing the mirror within the recessed area of the cap, the basin, whose walls are then used "to surround tightly or firmly; envelop or enclose", the definition of embed, which results in the
15 compression forces used to retain the cap.

Examiner alleges, "the step of embedding does not necessarily require an compression force toward the center of the basin." In the absence of a compression force created by forcing an oversized reflective surface into the basin, there would be no means of securing the reflective surface to the basin, it would simply be sitting in a recess and would fall out when tilted at an
20 angle or turned over. To secure a reflective surface within a basin of equal or larger size, and adhesive would be needed, while forcing a slightly larger reflective surface into a basin, resulting compression forces between the depths of their respective sides acts to secure the reflective surface within the basin.

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as being indefinite and not clear what compression force is exerted toward the center of the depth of the basin. The present invention eliminates the need to use a glue or other adhesive product, instead teaching a cap with a basin that has a larger depth than the reflective surface and is slightly smaller than that of the reflective surface that is to be inserted, this is Embedding. The reflective surface is inserted into the basin and is held in place by the compression forces exerted against its depth by the depths of the basin walls. During the manufacturing process the reflective surface, which is slightly larger than the basin opening, is forced into the basin under pressure. Once located in the basin, the reflective surface's smaller depth allows it to be held in place by the compression forces of the polymer, which is slightly stretched.

Issue (b). The subject matter of Claims 1, 4, and 6 is patentable in view of Speshyock, under 35 USC 102.

With respect to claims 1, 4, and 6, Examiner cites '281, stating that it discloses a contact lens case comprising: a base (verified by Fig 1, '281, item 1); a cover (verified by Fig 1, '281, item 2); at least one reservoir on the top side of the base having an outer surface (verified by Fig 2, '281); a cover having its own outer surface and attachable to the base via its own threads (verified by Fig 1, '281 item 18); a reflective surface covering said outer surface of said cover (verified by Fig 1, '281, item 5); and said cover having a basin and the reflective surface has a depth less than the basin depth.

With respect to claims 1 and 4 anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* Claims 1, 4, and 6 were

amended to include the language “in combination” explicitly making the claims a specific combination of the elements claimed therein.

Here ‘281 refers to a “cover.” The Examiner refers to this cover containing a mirror. In Fig. 2 of ‘281, the cover that ‘281 refers to is removed, showing the 'lens holding portion.'

5 'lens holding portion' is the contact lens case. In the first claim of ‘281, it also states the invention has a contact lens holding means, which includes a base and cover that can have a mirror, and the invention has a contact lens storage means, which is the case in the present invention. They are two separate and distinct parts of ‘281. ‘281 teaches a mirrored cover case for a contact lens case, while the present invention on teaches a contact lens case wherein mirrors
10 are secured to the removable caps, not to another case.

Column 3, lines 70-75 of ‘281 discusses the cover; base; and fluid-containing compartments bounded by bottom, sidewall and removable caps. The cover is separate from the removable caps of the fluid containing compartments. Column 5, line 13 of ‘281 states "all the
15 embodiments utilize the same lens holding cap element." This lens holding cap element is not mirrored. The cover can be mirrored. The word "mirror" appears only once in ‘281 in column 3 line 49.

The Examiner's description in the office action closely follows Appellant’s description on page 2 of the present application and is not supported by ‘281 or any other cited reference. The mentioned mirrored “cover” in Examiner’s rejections cannot possibly refer to ‘281 as the 'cover'
20 in ‘281 is not a threaded connection to the base. The present invention describes a mirrored cover (cap) for a contact lens case. ‘281 merely describes a mirrored cover for the cover for a contact lens case.

The sixth element in Appellant's claims is not taught, suggested, or anticipated by '281. Examiner provides no citation to the teaching of a cover or cap having a basin wherein the reflective surface has a depth less than the basin depth in '281. '281 teaches a mirrored case that holds a contact lens case (see column 3, line 48), it is *not* a mirrored contact lens case but a case
5 for a contact lens case.

Appellant emphasized the differences between the present application and the teaching of '281 and the claim language of such differentiations of the present application. Specifically, the present application is narrowly focused on a basin on a cap that covers the area for storing a contact lens and is not a case for a contact lens case as that taught by '281. Appellant's invention
10 incorporates a reflective surface on a contact lens case in a unique and non-obvious way, while '218 merely teaches a case comprising two parts, which allow for the storage of a contact lens case and other materials, with one part of the case having a reflective surface. There is no mention of teaching in '218 of how to secure the reflective surface to a case, and '281 does not teach the use of a basin or any specific size. Appellants point is confirmed by Examiner's
15 position in the office action when Examiner states "mirror appears to be attached" (emphasis added).

Claim 6 stands rejected under 35 USC Section 102(b) as being anticipated in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as '281. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not
20 enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* By Examiner's own words, and lack thereof, it is clear that '281 does not teach the use of a basin for receiving a mirror. Examiner has made no citation to such a teaching in '281

and ever further, in under Examiner's Claim Rejections – 35 USC Section 102, Examiner writes "but in the event that it is not attached" clearly an indication the Examiner can not support or is not sufficiently certain of the required disclosure under 35 USC 102 in '281.

Furthermore anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as previously discussed, '281 does not disclose the use of basin to secure the mirrored surface using embedding techniques or compressive pressure from the side wall of a basin as claimed by Appellant. Additionally, '218 does not teach or suggest the specific relationship of the reflective surface and the basin, such that the basin wherein the reflective surface has a depth less than the basin depth is required.

Withdrawal of this rejection is respectfully requested.

Issue (c). The subject matter of Claims 1-14 is patentable in view of Ulmer, et al.,

Girard, Ament, De Meo, and Lin.

Again for complicity, a prima face case of obviousness is established when an examiner provides: one or more references, that were available to the inventor and, that teach, a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, an Appellant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facia case of obviousness form being established.

With respect to Claims 1-11, Examiner alleges that '780 discloses "a least one reservoir on the top side of the base and having an outer surface with threads;" A cap for the reservoir is attached to the outer surface of the reservoir by threads." This is a misstatement or misunderstanding of the teaching of '780. '780 teaches a cap 18 with a base fixed in such a manner that the cap 18 and base 20 may be removed from a container 14 with the base 20

attached. It is the container 14, which has a mirrored surface 60, not the cap 18. '780 does not suggest or teach the use of a mirrored surface on the cap 18, it only teaches the use of a mirrored surface 60 on the container 14. Thus, Examiner's arguments are not supported.

The cap 18 of '780 is separable from the lens storing area or container 14, which is the basis of improvement for the present invention. The present invention allows a user to remove a cap and use a mirror located on the cap to assist in the asserting of a contact into the eye, while '780 would require a user to handle and wave around the container 14 while using the mirrored surface 60 of the container 14, which is more difficult to hold steady due to its weight and size with also the potential for spilling the cleaning and sterilization fluid from the container 14.

Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by '579 and '452 for lipstick cases for use on a contact lens case of '780. Also, with respect to Examiner's allegation that it would be "obvious to secure the mirror to prevent if from inadvertent removal from the basin," again, how does the Examiner know that '780, '579, or '452 didn't contemplate removal? The Examiner can *not* claim it is obvious under '780, '579, or '452 to attach the mirror due to its lack of teaching and the possibility of a desirable effect for removability or attachment at a different location.

With respect to Claims 1, 4, and 5 which stand rejected under 35 USC 103(a) as being unpatentable over De Meo. ('477) in view of Girard ('597) and/or Amet ('452) Appellant and/or Official Notice respectfully disagrees. Appellant concedes that '477 does teach what could be called a "standard contact lens case" which is well known in the prior art, and is incorporated in the present invention that comprises, at least one reservoir, a base with an outer surface, and an attached cap. Examiner's allegation that '477 "appears to have a mirrored surface" is incorrect. The title, claim and description of the Figures in '477 is absent of any reference to the type of

surface or materials. Additionally, the figures themselves show no reflective surfaces.

Examiner's position is completely nonsensical in view of all the cited prior art made of record in this prosecution and Appellant's application, all of which clearly illustrate reflective surfaces in their line drawings, while '477 shows one surface appearance for the entire contact lens case.

5 Official Notice is also not sufficient to supply motivation for modifications. The factual inquire to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection, they have failed to establish the prima facie case of obviousness. Here Examiner fails to states the specific element or motivation that is being taken. If it is "to secure the mirror within the
10 cap...." in view of '570 or '452, then Examiner's statements are inconsistent as Examiner first argued Official Notice in a previous Office Action, but now argues "obviousness" without being able to cite any prior art references.

 With respect to Claim 6, Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by '579 and '452 for lipstick cases for use on a contact lens
15 case. Also, Examiner's allegation that it would be "obvious to secure the mirror to present if from inadvertent removal from the basin," how does the Examiner know that '281, '579, or '452 didn't contemplate removal? The Examiner can *not* claim it is obvious or use hindsight under '281, '579, or '452 to attach the mirror due to its lack of teaching and the possibility of a desirable effect for removability.

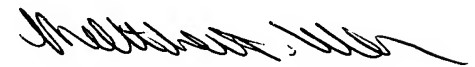
20 With respect to Claims 2-3 and 7-8 Appellant concedes that it is known in the prior art to engage the cap to the base of a contact lens by thread as disclosed by Lin '314. Appellant respectfully relies on the same arguments for Claim 1, from which Claims 2 and 3 depend, and Claim 6 from which Claims 7 and 8 depend.

XI. Conclusion

Appellant respectfully submits that the references relied upon by the Examiner fails to suggest or teach the configuration of the claimed invention, and the respective rejections relying upon the art of record, are improperly founded both in fact and in law. Therefore, the Examiner's rejections should be reversed and a decision rendered favorable to the appellant.

Accordingly, the Honorable Board of Patent Appeals and Interferences is respectfully requested to reverse the Examiner's rejection of Claims Under 35 USC 112, 102, and 103 and render a decision favorable to Appellant and allow Claims 1-14 as amend in the response Filed by Appellant/Appellant on 19 July 2006 and now pending, or to allow Claims 1-14 as amend in the response Filed by Appellant/Appellant on 19 July 2006 with the opportunity to make any after Final corrections to Claims 9, 12, and 14 to overcome the 35 USC 112 rejections, or cancel any Claims not found allowable by this Board.

Respectfully submitted,



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Appendix A

1. A contact lens case for storing contact lenses comprising in combination:

a base having a top side;

5 one or more reservoirs for storing a contact lens on the top side of said base and having an outer surface;

a corresponding cap for each of said reservoirs, said cap being attached to the outer surface of said corresponding reservoir and each cap having its own outer surface and basin; and

a reflective surface covering for the outer surface of at least one cap wherein said
10 reflective surface covering is of a depth that is less than that of the depth of said basin and is secured within said basin.

2. The contact lens case of claim 1, wherein said outer surface of said reservoir includes threads.

15 3. The contact lens case of claim 2, wherein each said cap has an inner surface that includes threads adapted to engage said threads of said reservoir.

4. The contact lens case of claim 1, wherein said outer surface of at least one said cap includes said basin.

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5. The contact lens case of claim 4, wherein said reflective surface is adhered within said basin, and having a reflective outer surface.

6. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

at least one reservoir for storing a contact lens on the top side of said base and having an

5 outer surface;

a cap having a basin for said at least one said reservoir, said cap being removeably attached to the outer surface of said at least one said reservoir and having an outer surface; and

a reflective surface attached to the outer surface of at least one said cap and having a reflective outer surface wherein said reflective outer surface is of a depth that is less than that of

10 the depth of said basin and is secured within said basin.

7. The contact lens case of claim 6, wherein said outer surface of said reservoir includes threads.

8. The contact lens case of claim 8, wherein said cap has an inner surface that includes threads

15 adapted to engage said threads of each respective said reservoir.

9. The contact lens case of claim 8, wherein said reflective surface is secured within said basin toward the center of the depth of said basin against the depth of said reflective surface.

20 10. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

on the top side of said base at least one reservoir for storing a contact lens having an outer surface with threads;

a cap for said at least one said reservoir, said cap being removeably attached to the outer surface of each said reservoir and having an outer surface; and

5 a reflective surface adhered to the outer surface of said at least one said cap.

11. The contact lens case of claim 10, wherein said cap has an inner surface that includes threads adapted to engage the threads of each respective said reservoir.

10 12. The contact lens case of claim 8, wherein said reflective surface is secured within said basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface.

13. The contact lens case of claim 4, wherein said reflective surface is embedded within said
15 basin, and having a reflective outer surface.

14. The contact lens case of claim 9, wherein the securing means of the reflective surface within the basin are the compression forces created by the depth of said basin against the depth of said reflective surface where said reflective surface has a slightly larger diameter than said basin.

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